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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/226,577

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JACK CHANEY

SAMI.PAU.58

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Myers Andras Sherman LLP  
19900 MacArthur Blvd.  
Suite 1150  
Irvine, CA 92612

EXAMINER

CALLAHAN, PAUL E

ART UNIT

PAPER NUMBER

2437

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DELIVERY MODE

03/17/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/226,577	<b>Applicant(s)</b> CHANEY, JACK	
	<b>Examiner</b> PAUL CALLAHAN	<b>Art Unit</b> 2437	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,10-14 and 44-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7,14,45 and 47 is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6,8,10,11,13,44 and 46 is/are rejected.
- 7) ☒ Claim(s) 5 and 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This Office Action is directed towards the Applicant's response filed 12-30-2008.
2. Claims 1, 3-8, 10-14, and 44-47 are pending and have been examined.
3. The indicated allowability of claims 1-5 and 44 is withdrawn in view of the newly discovered reference(s) to Van Wie et al., US 5,943,422. Rejections based on the newly cited reference(s) follow.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1, 3, 4, 6, 8, 10, 11, 13, 44, and 46 are rejected under 35 U.S.C. 102(e) as being anticipated by Van Wie, US 5,943,422. Van Wie teaches:

As for claim1: a method of copy-protecting a digital audio-visual signal (abstract), comprising the steps of: (a) encoding the digital audio-visual signal to obtain an encoded signal (fig. 7A, col. 5 lines 30-65, ; (b) converting the encoded signal into a copy protected signal using a copy protection function that utilizes a copy protection data signal to prevent using the digital audio-visual signal without access to the copy protection data signal (col. 18 line 60 through col. 19 line 10, col. 10 lines 50-55); (c) scrambling the copy protected signal to obtain a scrambled signal; and (d) transmitting the scrambled signal and said copy protection data signal to a receiver for subsequent recovery of said digital audio-visual signal (col. 18 line 60 through col. 19 line 10, col. 13 lines 20-25).

As for claim 3: the method of claim 1, wherein the step of transmitting comprises the step of transmitting the scrambled signal and said copy protection data signal as a single signal to the receiver (col. 18 line 60 through col. 19 line 10).

As for Claim 4: the method of claim 3, wherein the step of transmitting further comprises combining the scrambled signal and said copy protection data signal into

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said single signal (fig. 7A, col. 16 line 60 through col. 17 line 45, col. 18 line 60 through col. 19 line 10).

As for claim 44: the method of claim 1, wherein the copy protected signal cannot be useably viewed, displayed, copied or recorded without access to the copy protection data (col. 10 lines 50-55).

As for claims 8, 10, 11, 13, and 46, the claims are directed towards the system carrying out the method steps of claims 1, 3, 4, 6, and 44. Claims 8, 10, 11, 13, and 46 recite substantially the same limitations as do claims 1, 3, 4, 6, and 44 and are rejected on the same basis as those claims.

***Allowable Subject Matter***

6. Claims 7, 14, 45, and 47 are allowed.

7. Claims 5 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter: The closest prior art in the field does not teach the combination of features set forth in dependent claims 5 and 12 including their base and any intervening claims, or in

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independent claims 7 and 14. The novel and unobvious features comprise the sequence of steps performed in the receiver of recovery of a copy control data signal from the received signal, extracting the scrambled signal from the received signal, descrambling the scrambled signal to recover a copy protected signal, use of an inverse copy protection function to recovered an encoded original signal, decoding the original signal, and governing the use of the original signal via use of the copy control data signal.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (571) 272-3869. The examiner can normally be reached on M-F from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Emmanuel Moise, can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is: (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Paul Callahan/

Art Unit 2437

/Emmanuel L. Moise/

Supervisory Patent Examiner, Art Unit 2437